

### **REMARKS**

Claims 1-25 are currently pending in this application. Claims 1 and 21 have been amended by this response. Please enter the above amendment and consider the following remarks.

#### **§ 112 Rejection**

The Examiner has rejected claim 21 under 35 U.S.C. § 112, second paragraph as being incomplete for allegedly omitting essential steps. Applicant has amended claim 21 to more particularly detail the interrelation between the claim limitations. Specifically, Applicant has clarified that the replacement cards replace none or more of the dealt cards to form a final hand. Thus, Applicant believes claim 21 is currently in condition for allowance.

#### **§ 101 Rejection**

The Examiner has rejected claims 1-10 and 21-25 under 35 U.S.C. § 101 because the claimed invention allegedly “lacks patentable utility.” Claims 1 and 21 have been amended to include the limitation that an award is provided when the determined poker hand ranking meets a predetermined criterion. Claims 2-10 and 22-25 depend from claims 1 and 21 respectively and as such include each and every limitation of these claims. Thus, claims 1-10 and 21-25 are believed to be in condition for allowance as amended because they clearly produce a useful, concrete, and tangible result.

#### **§§ 102(e) and 103(a) Rejections**

Claims 1, 4-5, 8-11, 14-15, and 18-22 stand rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Wolf (U.S. Publication No. 2004/0063483). Claims 2-3, 12-13, and 24-25 stand rejected as allegedly being unpatentable over Wolf in view of Baerlocher (U.S. Publication No. 2003/0153383). Claims 6-7, 16-17, and 23 stand rejected as allegedly being unpatentable over Wolf in view of Davids (U.S. Patent No. 5,833,536).

Wolf discloses a gaming device 10 that automatically determines which are the mathematically optimal or best cards 35 to hold, displays this suggestion 33 to the player and in

some embodiments automatically holds these cards 35 for the player. The player may choose to hold the cards 35 selected by the gaming device 10 or select other or no cards 35 to hold. The player then presses the deal button 20 and the unwanted cards 35 are removed from the display 30 and the replacement cards 35 are dealt from the remaining cards in the deck. *See* Wolf, ¶0033. The player may choose from two or more hold strategies to apply to the game. *See* Wolf, ¶0044.

Unlike the disclosed invention in Wolf, the Applicant's claimed invention replaces none or more non-winning cards from the dealt hand with replacement cards if and only if the dealt hand has one of the award-winning rankings. The Wolf disclosure repeatedly discusses selecting the mathematically optimal or best cards 35 as hold cards. *See* Wolf, Abstract, ¶¶0005-8, 0010, 0028, 0031, 0033, 0036, 0039, 0042, 0061. The mathematically optimal or best cards 35 may or may not form an award-winning hand. *See* FIGS. 4a-b. In fact, there are countless hands where the mathematically optimal hands are selected even where an award-winning hand is not dealt. Wolf does not disclose limiting the automatic distinguishing of cards within a dealt hand only when the dealt hand has one of the award-winning rankings contained therein, as specifically claimed by the Applicant.

The Examiner attempts to overcome this deficiency in Wolf by stating that Wolf "explicitly teaches the distinguishing step occurring if the dealt hand includes one of the award winning ranking by teaching a variety of different auto-hold strategies, including a 'conservative' strategy that teaches auto-holding cards which are part of an existing winning combination." However, even this "conservative" strategy is not limited to only distinguishing cards within a hand that contains an award-winning ranking. Even under this "conservative" strategy, Wolf would still select the mathematically optimal hands for a player even if the player's hand does not contain an award-winning ranking.

Nowhere does Wolf disclose, teach, or suggest distinguishing winning ones of the cards in a dealt hand from other ones if and only if the dealt hand has one of the award-winning rankings, as specifically claimed by Applicant. In fact, Wolf specifically teaches away from such an apparatus and method by explicitly and repeatedly reiterating that the gaming device 10 automatically determines which are the mathematically optimal or best cards 35 to hold. As

every single dealt hand will have “mathematically optimal” cards 35 to hold, Wolf teaches away from distinguishing cards only if the hand has one of the award-winning rankings. Additionally, the overall purpose of Wolf is to display to a player the mathematically optimal or best way to play a game. *See* Wolf, Abstract. To limit Wolf to only applying to dealt hands when they include an award-winning ranking, as the Examiner states, would undermine the purpose and teachings of Wolf. Thus, it is clear that Applicant’s claimed invention is not anticipated by Wolf.

Additionally, neither Baerlocher nor Davids disclose, teach, or suggest distinguishing winning ones of the cards in a dealt hand from other ones if and only if the dealt hand has one of the award-winning rankings, as specifically claimed by Applicant. Thus, neither Baerlocher nor Davids overcomes this deficiency of Wolf. As such, the combination of Wolf with either or both of Baerlocher and Davids does not render Applicant’s claimed invention obvious. As each and every one of Applicant’s pending claims contains the above limitation, claims 1-25 are believe to be allowable for at least the above reasons.

#### Conclusion

In conclusion, Applicant respectfully submits that all claims are in condition for allowance and such action is earnestly solicited.

If there are any matters which may be resolved or clarified through a telephone interview, the Examiner is respectfully requested to contact Applicant’s undersigned attorney at the number indicated. Applicant believes that no fee is due with respect to this Amendment and Response, however, should any additional fees be required (except for payment of the issue fee), the Commissioner is authorized to deduct the fees from Jenkins & Gilchrist, P.C. Deposit Account No. 10-0447, Order No. 47079-00227USPT. A duplicate copy of this Amendment and Response is enclosed for that purpose.

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